

PATENT

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

Application Number: 10/720,404

Filing Date: 11/24/2003

Applicant(s): Christopher Hyland and Fernando Salazar

Entitled: USER CUSTOMIZABLE REPORTING

Examiner: Nathan Hillery

Group Art Unit: 2176

Attorney Docket No.: LOT920030068US1 (7321-022U)

REPLY BRIEF

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
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Sir:

This Reply Brief is submitted under 37 C.F.R. § 41.41 in response to the EXAMINER'S ANSWER dated May 28, 2008.

The Examiner's response to Appellant's arguments submitted in the Appeal Brief of March 11, 2008, raises additional issues and underscores the factual and legal shortcomings in the Examiner's rejection. In response, Appellant relies upon the arguments presented in the Appeal Brief of March 11, 2008, and the arguments set forth below.

In response to the arguments presented on pages 4 and 5 of the Appeal Brief, the Examiner asserted the following on page 8 of the Examiner's Answer.

First, appellant is not fully appreciating the references as a whole. A reference is valid for all that it teaches and appellant is simply focusing on one paragraph block of one reference.

The Appellants observe, however, that it is the Examiner's responsibility to particularly denote relevant portions of a cited reference relied upon in establishing a prima facie case of obviousness. Specifically, 37 C.F.R. 1.104(c)(2) provides:

In rejecting claims for want of novelty or for obviousness, the examiner must cite the best references at his or her command. When a reference is complex or shows or describes inventions other than that claimed by the applicant, **the particular part relied on must be designated as nearly as practicable. The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified.**

Examiner relied specifically upon paragraph [0772] of Helgeson for the teaching of "embedding business rule enforcement logic in said selected screen, the business rule enforcement logic enforcing business rules for accessing data in a database." If Examiner intended to rely upon a different portion of Helgeson for this teaching, Examiner had (and still has) the legal obligation under 37 C.F.R. 1.104(c)(2) to designate the different portion with particularity--especially given the voluminous nature of the Helgeson reference.

On pages 8 and 9 of the Examiner's Answer, with respect to Appellants' arguments of page 5 of the Appeal brief in which Appellants stated, "Despite Examiner's argument, it is apparent to the Appellants that nothing in paragraph [0772] suggests the "enforcement of business rules", Examiner further asserted,

For the sake of brevity, it should be noted that appellant does not explain how or why the claim language distinguishes from the applied references. Specifically, the position of the Office is that Helgeson teaches that Model pages are responsible for producing an XML representation of the content of the page. This content typically comes from executing complex business logic (e.g., running

database queries, exercising business APIs, etc.). Clearly, executing complex business logic, for example running database queries, meet the claim limitation that business rule enforcement logic enforces business rules for accessing data in a database. There is no proof or rebuttal as to how or why the business logic of Helgeson is different. Appellant has pointed solely to the lack of the term "enforcement" in Helegeson.

In response, Appellants first observe that Appellants did in fact "explain how or why the claim language distinguishes from the applied references" in that Appellants pointed out the complete absence of any explicit or inferred teaching in paragraph [0772] directed to the "enforcement of business rules" as expressly provided for in Appellants claims 8 and 15.

Further, Appellants stated on page 5 of the Appeal Brief,

Yet, to properly maintain a prima facie case of obviousness, the Examiner must find every limitation literally or by inference to be present in the cited reference.

Examiner still has not pointed to a particular teaching by reference to paragraph or line number that literally teaches the enforcement of business rules. On pages 8 and 9 of Examiner's Answer, Examiner appears to argue that Helgeson infers or otherwise implicitly teaches the "enforcement of business rules". Even still, inherency may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient to establish inherency.¹ To establish inherency, the extrinsic evidence must make clear that the missing element must necessarily be present in the thing described in the reference, and that the necessity of the feature's presence would be so recognized by persons of ordinary skill.²

¹ In re Rijckaert, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) (reversed rejection because inherency was based on what would result due to optimization of conditions, not what was necessarily present in the prior art); In re Oelrich, 666 F.2d 578, 581-82, 212 USPQ 323, 326 (CCPA 1981).

² Finnegan Corp. v. ITC, 180 F.3d 1354, 51 USPQ2d 1001 (Fed. Cir. 1999); In re Robertson, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999); Continental Can Co. USA v. Monsanto Co., 20 USPQ 2d 1746 (Fed. Cir. 1991); Ex parte Levy, 17 USPQ2d 1461 (BPAI 1990).

Furthermore, reference is made to Ex parte Schricker,³ in which the Honorable Board of Patent Appeals and Interferences stated the following:

However, when an examiner relies on inherency, it is incumbent on the examiner to point to the "page and line" of the prior art which justifies an inherency theory. Compare, In re Rijckaert, 5 F.3d 1531, 1533, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) (when the PTO asserts that there is an explicit or implicit teaching or suggestion in the prior art, it must indicate where such a teaching or suggestion appears in the prior art); In re Yates, 663 F.2d 1054, 107, 211 USPQ 1149, 1151 8 (CCPA 1981).

Assuming the Examiner relies upon an argument of inherency (which may not be the case), the Examiner would have not discharged that burden of indicating where such a teaching appears in the prior art. Thus, the Examiner could not have established that the limitation of "enforcing business rules" is inherently disclosed by Helgeson. In this regard, the Examiner is also referred to M.P.E.P. § 2112, entitled "Requirements of Rejection Based on Inherency; Burden of Proof."

In any event, on page 9 of Examiner's Answer, Examiner equates "enforcement of business rules" with the calling of a computer method comporting with the well-known design pattern, "Command" as described by Gamma et al., Design Patterns: Elements of Reusable Object-Oriented Software, at 233-242 (Addison-Wesley 1994), hereinafter, Gamma. In particular, Examiner states,

However, Helgeson continues to teach that Web Content Server 800 introduces an implementation of the Command pattern (Gamma et al.). A developer can invoke a command from a model page by using the execute Web Content Server 800 tag library tag. The skilled artisan would have interpreted the implementation and/or invocation of a command pattern to invoke commands as enforcement especially in light of the example taught by Helgeson:

<wdktags:execute manager="CatalogCommandMgr" command="search"/>.

Examiner has provided no evidence of how a method call to the object CatalogCommandMgr that comports with the Command design pattern is equivalent to the enforcement of business

rules as claimed by Appellants. In fact, it is well known as taught literally in the Gamma text that the Command design pattern "creates objects which encapsulate actions and parameters." Thus, the use of the Command design pattern bears no relationship to the use, embedding or enforcement of business rules. In fact, Examiner's entire argument is devoid of any relevant evidentiary support and represents Examiner's off-the-cuff reasoning at best.

In sum, the Examiner has yet to meet the Examiner's obligations under 35 U.S.C. § 103(a) in meeting a prime facie case of obviousness because the Examiner has not provided direct or inherent teachings of any cited reference that discloses

embedding business rule enforcement logic in said selected screen, the business rule enforcement logic enforcing business rules for accessing data in a database; as claimed expressly in claims 8 and 15. For the reasons set forth in the Appeal Brief of January 28, 2008, and for those set forth herein, Appellants respectfully solicit the Honorable Board to reverse the Examiner's rejection under 35 U.S.C. §§ 102 and 103.

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 12-2158, and please credit any excess fees to such deposit account.

Date: July 28, 2008

Respectfully submitted,

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